

Remarks

This Amendment is in response to the Office Action of October 16, 2009, in which the Examiner rejected claims 1-4, 7, 8, 11-13 and 17 under 35 U.S.C. 112, second paragraph. The Examiner also rejected claims 1-4, 6-13 and 17 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0120846 ("Stewart") in view of U.S. Patent Application No. 2003/0115189 ("Srinivasa"). Prior to this amendment, claims 1-4, 6-13, and 17 were present for examination. Claims 1, 2, 4, 7, 8, and 13 have been amended. No claims have been added or canceled. Therefore, claims 1-4, 6-13, and 17 stand pending for examination.

§112 Rejections

Claims 1-4, 7, 8, 11-13 and 17 stand rejected as allegedly indefinite under §112 due to the use of various words and phrases . Each §112 rejection is addressed below in turn.

Claim 1

The Office Action held that the terms "associated with," "participant institution," "regular basis," "matches," "corresponds to," "does not match," and "indicating" are all unclear and render the claim indefinite. In order to advance prosecution, Applicant has amended claim 1 to either replace or further define some of these phrases.

"Associated with" has been replaced with the phrase "linked to." As shown in Figure 1, "account-owner data elements" are linked to "accounts maintained at at least one participant institution." "Participant institution" has been explicitly defined as "entities that are obligated to provide account-owner data to the account-owner verification database."

The term "matches," as used in ¶36 of the Application and in claim 1, employs a standard dictionary definition: "thing equal or similar to another." *Merriam-Webster Online Dictionary*, 2010, <http://www.merriam-webster.com/dictionary/match>. Similarly, the phrase "does not match" refers to things *not* equal or similar to another. Therefore, the word "matches" and the phrase "does not match" have not been amended. Applicant believes the above definition should clear any ambiguity regarding the meanings of the word and phrase.

Applicant respectfully traverses the §112 rejection related to the phrase “regular basis.” This is simply an objection to the *breadth* of the claim, and not to its *definiteness*. “Breadth of a claim is not to be equated with indefiniteness.” MPEP 2173.04, *citing In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). As recited, these claims are not limited to any particular regular basis. For example, the “regular basis” may be every day, every hour, or every week. Further, the Office Action has not articulated how this breadth in the claim renders those limitations that are recited indefinite.

The phrase “corresponding to” is present in claim 1 and at least ¶36 of the Application. As used in both claim 1 and the Application, “corresponding to” refers to “[h]aving the same or nearly the same relationship.” *American Heritage Dictionary*, 2010, <http://education.yahoo.com/reference/dictionary/entry/corresponding>. For example, as used in claim 1, a check image would “correspond to” a particular check. Therefore, the check image would be an image of that particular check.

The word “indicating” has been removed. Instead of stating “supplies information indicating,” claim 1 now recited “specifies.” Applicant believes this amendment removes all ambiguity regarding the use of the word “indicating.”

Further, claim 1 stands rejected under §112 for allegedly being an “omnibus type claim.” *Office Action*, p. 2. The Office Action states that “[t]he recitation ‘the non-participant institutions are entities that are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database’ does not serve to limit the institutions that are considered ‘non-participant’ since virtually any type of institution can be included in this description.” *Id.*, at p. 3. Applicant respectfully disagrees.

Amended claim 1 clearly defines both “participant” and “non-participant” entities. “Non-participant” entities clearly do not include “participant” entities. While the Examiner alleged that virtually any entity satisfies the non-participants definition of entities that “are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database, . . .” *participant* entities do not satisfy this definition. Further, the definition of non-participant entities has been expanded to recite: “the non-participant institutions are entities that are capable of supplying account-owner data,

but are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database. . . ." Therefore, only entities that can supply account-owner data may qualify as non-participant institutions.

Applicant believes these amendments and remarks address and resolve all §112 rejections of claim 1. Applicant respectfully requests withdrawal of the §112 rejections of claim 1.

Claim 2

Referring to the §112 rejection related to the term "periodically," it appears this is also simply an objection to the *breadth* of the claim, and not to its *definiteness*. The definition of periodically is "at regular intervals of time" or "from time to time." *Merriam-Webster Online Dictionary*, 2010. <http://www.merriam-webster.com/dictionary/periodically>. For example, the "periodic updating" of claim 2 may be hourly, daily, weekly, monthly, etc. The recitation of the word "recently" has been removed to resolve any ambiguity stemming from its use.

Applicant believes these amendments and remarks address and resolve all §112 rejections of claim 2. Applicant respectfully requests withdrawal of the §112 rejection of claim 2.

Claim 3

The Office Action alleges that the use of "participant" and "non-participant" institutions "describes all conceivable institutions." Applicant believes that the restriction of "non-participant" institutions to entities that "are capable of supplying account-owner data, but are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database" properly limits the scope of non-participant institutions.

Applicant believes these amendments address and resolve the §112 rejection of claim 3. Applicant respectfully requests withdrawal of the §112 rejection of claim 3.

Claim 4

The term "associated" has been removed. Applicant has replaced it with the term "linked" to represent the nature of the relationship between the account-owner data elements and the account numbers.

Applicant believes this amendment addresses and resolves the §112 rejection of claim 4. Applicant respectfully requests withdrawal of the §112 rejection of claim 4.

Claim 7

Applicant believes the remarks provided in relation to claim 1 regarding the phrase “regular basis” and “does not match” properly address the rejection of claim 7. Also, the Office Action identifies the phrase “wherein the response is negative for a given data element if the account-owner data stored in the data element field corresponding to the entered account number does not match the entered data element, or the response supplies information indicating that information is unavailable for a given data element if there is no account-owner data stored in the data element field corresponding to the entered account number” as being unclear and indefinite. *Office Action*, p. 5. The Office Action does not state specifically what part of this phrase is allegedly indefinite or unclear. As such, Applicant has amended claim 7 similarly to claim 1, to replace the phrase “supplies information indicating” with “specifies.”

The Office Action also rejects claim 7 under §112 because “participant data elements and non-participant data elements” and “the non-participant institutions are entities not obligated to provide account-owner data to the database” do not establish metes and bounds for the claim. *Id.* Claim 7 has been amended to state that non-participating institutions are “entities capable of supplying account-owner data, but are not obligated to provide account-owner data to the database.” While participant institutions are “entities that provide account-owner data to the database on a regular basis,” non-participant institutions are entities capable of doing as such but are not obligated to provide account-owner data.

Applicant believes these amendments and remarks address and resolve the §112 rejection of claim 7. Accordingly, Applicant respectfully requests withdrawal of the §112 rejections of claim 7.

Claim 8

As discussed in relation to claim 2, the rejection of claim 8 for using the term “periodic” is a rejection of the *breadth* of the claim, and not its *definiteness*. The definition of periodically is “at regular intervals of time” or “from time to time.” *Merriam-Webster Online*

Dictionary, 2010, <http://www.merriam-webster.com/dictionary/periodically>. For example, the “periodic updating” of claim 2 may be hourly, daily, weekly, monthly, etc.

Also, claim 8 has been amended to recite: “periodically updated with account-owner data elements from accounts opened or maintained in the participant institutions, wherein these account-owner data elements have not previously been updated in the database.” The use of the word “recently” has been removed.

Applicant believes these amendments and remarks address and resolve all §112 rejections of claim 8. Applicant respectfully requests withdrawal of the §112 rejections of claim 8.

Claims 11 and 12

Again here, the rejections based on non-participant data elements appear to be related to breadth, not indefiniteness. The Office Action identifies that “non-participant data elements extracted from check images and check printing data could include anything that is recorded on a check which is not concerned with participant data.” *Id.*, at p. 6. While the Examiner may interpret non-participant data elements as broad, he has not identified how it is *Indefinite*.

Claim 13

The Office Action held that the terms “associated with,” “regular basis,” “matches,” “corresponds to,” and “indicating” are all unclear and render the claim indefinite. These terms and phrases have been addressed in relation to claim 1 and Applicant hereby reiterates the same remarks.

Additionally, the Office Action indicates that the use of the phrase “according to” renders claim 13 indefinite and unclear. *Id.*, at p. 6. To clarify, the phrase “according to” has been removed and replaced by the word “by.” This substitution clearly indicates that the database is organized by account number.

The use of the phrase “maintained at” is also alleged to be unclear and renders the claim indefinite. This phrase has also been removed and substituted with the phrase “held by.” Applicant believes this clearly explains the relationship between the accounts, the participant, and the non-participant institutions.

The phrase “wherein the response is negative for a given data element if the account-owner data stored in the data element field corresponding to the entered account number does not match the entered data element, or the response supplies information indicating that information is unavailable for a given data element if there is no account-owner data stored in the data element field corresponding to the entered account number” is alleged to be unclear and render claim 13 indefinite. *Id.*, at p. 7. Applicant has made amendments similar to claim 7 in order to overcome the rejection.

The Office Action also rejects claim 13 because “the recitations ‘participant institutions and non-participant institutions’ & ‘the non-participant institutions are entities not obligated to provide account-owner data to the database’ fail to establishes metes and bounds for the claim language.” *Id.*, at p. 7. Claim 13 has been amended similar to claims 1 and 7 to further define non-participant institutions. For the same reasons, Applicant believes these amendments remove any ambiguity regarding the meaning of participant and non-participant institutions.

Applicant believes these remarks address and resolve the §112 rejections of claim 13. Applicant respectfully requests withdrawal of the §112 rejections of claim 13.

Claim 17

The phrase “corresponding to” is employed in both claim 17 and at least ¶36 of the Application. As discussed in the remarks relating to claim 1, “corresponding to” refers to “[h]aving the same or nearly the same relationship.” *American Heritage Dictionary*, 2010, <http://education.yahoo.com/reference/dictionary/entry/corresponding>. For example, as used in claim 17, a routing transit number corresponding to the entered account number refers to a number that identifies the institution that holds or maintains the entered account number.

Applicant believes these remarks address and resolve the §112 rejections of claim 17. Applicant respectfully requests withdrawal of the §112 rejection of claim 17.

§103 Rejections

Independent claims 1, 7, and 13 stand rejected as obvious over Stewart in view of Simivasa. Factual findings made by the Office are the “necessary underpinnings to establish obviousness.” MPEP § 2141(I). The Office must set forth “the relevant teachings of the prior

art relied upon.” MPEP § 706.02(j). Additionally, in *KSR v. Teleflex* (550 U.S. 398 (2006)), the Supreme Court noted that the analysis supporting a rejection under 35 U.S.C. § 103 must be made explicit. See MPEP § 2142. As will be discussed below, Appellant respectfully submits that the Office has not established a *prima facie* case of obviousness.

The Office Action acknowledges that Stewart, the primary reference, “fails to explicitly teach (ii) at least one data element corresponding to the entered account number; (e) querying by the computer system the account-owner verification database including which incise account-owner data associated with from accounts maintained at both the participant institutions and the non-participant institutions. . . .” *Office Action*, p. 11.

In order to teach, suggest, or otherwise prove obvious such recitations involving participant institutions and non-participant institutions, the Office Action introduces Srinivasa.

Id. The Office Action cites Srinivasa for disclosing:

Member and nonmember pages project to points outside and inside the sphere, respectively. While this method works and has the virtue of simplicity, it may not take into account the shape of the member probability distribution in the event subspace. More accurate page classification can be obtained by tailoring the shape of the decision surface to the probability distribution of the member class. A number of statistical classification algorithms can be used to create such nonlinear decision surfaces. The algorithms can “learn” the surfaces from a training set which contains examples of both members and nonmembers of the category, e.g. event class.

Office Action, p. 12, quoting *Srinivasa*, ¶53. It is unclear how the “member and nonmember” pages of Srinivasa may be interpreted as teaching, suggesting, or otherwise proving obvious the instant claims’ relationships to participant and non-participant institutions.

Srinivasa is generally directed to an “apparatus and method for providing application specific multi-dimensional information to an application running on a user computing device. . . .” *Srinivasa*, Abstract. In Srinivasa, “the E-Space 28 filter can be used to determine if the document belongs to any of a set of relevant category-specific learned concept sub-spaces, i.e. is a member document or not.” *Srinivasa*, ¶37. A member document is a document as part of “one of the learned concept subspaces 30. . . .” *Id.* Meanwhile, the non-

member documents can be rejected, with only member documents proceeding to an extraction unit. *Id.*

While Srinivasa does use the terms “member” and “nonmember,” it is unclear how determining whether a document is or is not a member of a specific category has any relation to the participant and non-participant institutions of the independent claims. In claim 1, a participant is defined as “entities that are obligated to provide account-owner data to the account-owner verification database.” Non-participant entities are defined as “entities that are capable of supplying account-owner data, but are not obligated to provide account-owner data to the account-owner verification database and that are unable to access the account-owner verification database.”

The member and non-member documents of Srinivasa are *documents* and are identified as member or non-member by whether they are part of a “learned concept sub-space.” This is wholly unrelated to the participant and non-participant institutions of the independent claims which are either obligated or not obligated to provide account-owner data to the account-owner verification database.

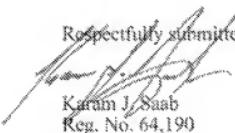
For at least these reasons, Stewart and Srinivasa fail to teach, suggest, or otherwise prove obvious each and every recitation of claims 1, 7, and 13. Because Stewart and Srinivasa do not prove obvious all of the recitations of claims 1, 7, and 13, and because such recitations have not been otherwise shown to have been known in the art at the time of the invention, *prima facie* cases of obviousness are not present. Consequently, Applicant respectfully requests withdrawal of the §103 rejections of claims 1, 7, and 13. Further, claims 2-4, 6, 8-12 and 17 depend, either directly or indirectly, from claims 1, 7, and 13. At least by virtue of their dependence on allowable base claims, these claims are likewise non-obvious. Accordingly, Applicant respectfully requests withdrawal of the §103 rejections of claims 2-4, 6, 8-12, and 17.

Conclusion

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Further, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this paper to Deposit Account No. 20-1430.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Karam J. Saab
Reg. No. 64,190

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
K4S:bhr
62339658 v1